

APR 30 2007

Patent

112.P14037

REMARKS

The above-referenced patent application has been reviewed in light of the Office Action referenced above. Reconsideration of the above-referenced patent application in view of the following remarks is respectfully requested.

Claims 1-28 are pending in the application. Claims 1-3, 5, 6, 8-17, and 21 have been amended. Claims 4, 7 and 22-28 have been cancelled. The amendment is fully supported by the original disclosure. No new matter has been introduced.

Claim rejections – 35 USC §102

Claims 1, 4-6, 9-14, 16, 21-23, 27 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Takahashi (JP Patent No. 58152737).

Claims 4, 22-23, 27 and 28 have been cancelled, so they will not be considered further herein.

Independent claim 1 has been amended to incorporate limitations from dependent claim 7 to now recite "*wherein the elastic member comprises a structure manufactured together with the body by injection molding*". Accordingly, Assignee requests that the rejection be withdrawn as the Examiner has failed to establish that Takahashi discloses the identical invention as is required for anticipation.

Likewise claims 5-6, 9-14, 16, 21 are also not anticipated due at least to their dependence on amended independent claim 1.

112.P14037

PatentClaim rejections – 35 USC §103

Claims 2, 3, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Collins in view of Ota (JP Patent No. 63092542). Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi in view of Chang et al. (U.S. Patent No. 5,324,019). Claims 15, 17-20 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi in view of Tanno et al. (US Patent No. 6,309,064).

Claims 4, 7 and 24-26 have been cancelled, so they will not be considered further herein.

In response, Assignee respectfully submits that claims 2, 3, 8, 15 and 17-20 are not obvious, at least on the same or similar basis as claim 1 as set forth above with respect to the anticipation rejection. Specifically, independent claim 1 has been amended to incorporate limitations from dependent claim 7 to now recite "*wherein the elastic member comprises a structure manufactured together with the body by injection molding*". Similarly independent claim 17 has been amended to incorporate limitations from dependent claim 7 to now recite "*wherein the elastic member comprises a structure manufactured together with the body by injection molding*". The Examiner is kindly reminded that the Examiner's initial burden of factually supporting any *prima facie* conclusion of obviousness includes that:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (See MPEP § 2143.03.)

In the Office Action the Examiner has conceded that Takahashi fails to disclose this feature, stating:

In regard to claim 7, Takahashi discloses the transmission mechanism is in a sheet handling device with inherently has a body. Takahashi does not disclose the elastic member is manufactured together with the body by injection molding. (See page 2 of the Office Action)

112.P14037

Patent

However, in the Office Action the Examiner has asserted that a combination of Chang cures Takahashi of this failure, arguing:

However, injection molding is well known in the art. Chang discloses components of the sheet handler made via injection molding (col. 3, line 40) and modifying Takahashi so the elastic member is manufactured by injection molding with the body, as taught by Chang, would have been obvious to one of ordinary skill in the art. (See pages 2-3 of the Office Action)

Assignee cannot agree. First, the Examiner has provided no support from Chang that it is well know to manufacture "*the elastic member ... by injection molding*", as is claimed. Conversely, the portion of Chang cited by the Examiner (col. 3, line 40) does not discuss an "elastic member" as asserted by the Examiner:

The document feeder of this invention includes a solid bracket preferably produced by an injection molding using a mold.

Further, even if the Examiner were to establish support from Chang that it is well know to manufacture an "*elastic member ... by injection molding*", the Examiner has further failed to provided support from Chang that it is well know to manufacture "*the elastic member together with the body by injection molding*", as is claimed. In the absence of the Examiner pointing to such a suggestion, Assignee requests that the rejection be withdrawn as the Examiner has failed to establish that the proposed combinations renders 2, 3, 8, 15 and 17-20 are obvious.

It is noted that claimed subject matter may be patentably distinguished from the cited references for additional reasons; however, the foregoing is believed to be sufficient. Likewise, it is noted that the Assignee's failure to comment directly upon any of the positions asserted by the Examiner in the office action does not indicate agreement or acquiescence with those asserted positions.

RECEIVED
CENTRAL FAX CENTER

APR 30 2007

Patent

112.P14037

Conclusion

In light of the foregoing, reconsideration and allowance of the claims is hereby earnestly requested.

Any fees or extensions of time believed to be due in connection with this amendment are enclosed herein; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account 50-3703.

Invitation for a Telephone Interview

The Examiner is invited to call the undersigned attorney, James J. Lynch, at (503) 439-6500 if there remains any issue with allowance.

Respectfully submitted,
Attorney for Assignee

Dated: April 30, 2007

/James J. Lynch Reg. No. 50,153/
James J. Lynch
Reg. No. 50,153

Customer Number: 43831
Berkeley Law & Technology Group, LLP
1700 NW 167th Place, Suite 240
Beaverton, OR 97006
503.439.6500